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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,952	11/05/2001	David Kammer	035451-0169 (3707.Palm)	2782

26371 7590 07/14/2006

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ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 07/14/2006

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/006,952
Filing Date: November 05, 2001
Appellant(s): KAMMER, DAVID

Matthew J. Swietlik
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/1/2006 appealing from the Office action mailed 12/1/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,246,376	Bork et al.	6-2001
6,542,750	Hendrey et al.	4-2003
6,389,290	Kikinis et al.	5-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5, 8-13, 15-21 and 23-29 rejected under 35 U.S.C. 103(a) as being unpatentable over Bork et al (US-6,246,376 hereafter Bork) in view of Hendrey et al. (US-6,542,750 hereafter, Hendrey).

Regarding claim 1, Bork discloses a method of communicating between a handheld computer and other local area computing devices have wireless communication capability. (Col. 1 lines 31-35) Bork discloses a handheld computer that identifies a plurality of other wireless local area computing devices, creating an identifier for the other devices to be displayed on a display. (Col. 1 lines 55-57, Col. 3 lines 29-47 and Col. 5 line 49 through Col. 6 line 16) Bork differs from the claimed invention by not mentioning a listing of the identifiers on a display that can be sorted by distance and selecting the identifier to initiate information sharing. However, Hendrey teaches a method and system for selectively connecting mobile users for communication based on physical proximity that includes a communication device (Fig. 2 [201]) with a proximity sorting system. (Fig. 2 [222], Col. 1 lines 14-19 and Col. 10 lines 1-21) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the proximity sorting communications device of Hendrey into the handheld computer communications system of Bork. One of ordinary skill in the art would have been motivated to do this since sorting the distance to different objects can minimize the traveling distance between multiple objects.

Regarding claim 2, Bork discloses a handheld computer that is configured to communicate using the BLUETOOTH® standard. (Col. 1 lines 31-35)

Regarding claim 3, Bork discloses a handheld computer that is configured to communicate using the IEEE 802.11 standard. (Col. 1 lines 31-35)

Regarding claim 4, Bork discloses a handheld computer that is configured to communicate using the RF signals. (Col. 1 lines 31-35)

Regarding claim 5, Bork discloses a handheld computer that is configured to communicate using the infrared signals. (Col. 1 lines 31-35)

Regarding claim 8, Bork discloses a method of identifying and sharing information between a handheld computer and a group of local area computing devices having wireless communication capability within a specified distance. (Col. 3 lines 40-47) Bork discloses that a message can be transmitted to one or more local area computing devices having wireless communication capability within the specified distance. (Col. 4 lines 9-11) Bork differs from the claimed invention by not mentioning a listing of the identifiers on a display that can be sorted by distance, selecting the identifier to initiate information sharing and transmitting additional information. However, Hendrey teaches a method and system for selectively connecting mobile users for communication based on physical proximity that includes a communication device (Fig. 2 [201]) with a proximity sorting system. (Fig. 2 [222], Col. 1 lines 14-19 and Col. 10 lines 1-21) Hendrey teaches a message with location information and a request for a match making with a closely located user. (Col. 9 lines 54-67) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the proximity sorting communications device of Hendrey into the handheld computer communications system of Bork. One of ordinary skill in the art

would have been motivated to do this since sorting the distance to different objects can minimize the traveling distance between multiple objects.

Regarding claim 9, Bork discloses a handheld computer with a touch screen display. (Fig. 1 & 3, Col. 7 lines 49-50)

Regarding claim 10, the limitations of the claim are rejected as being the same reason set forth in claim 2.

Regarding claim 11, the limitations of the claim are rejected as being the same reason set forth in claim 3.

Regarding claim 12, the limitations of the claim are rejected as being the same reason set forth in claim 4.

Regarding claim 13, the limitations of the claim are rejected as being the same reason set forth in claim 5.

Regarding claim 15, Bork discloses that a message can be received from one or more local area computing devices having wireless communication capability within the specified distance. (Col. 4 lines 9-11)

Regarding claim 16, Bork discloses a housing, a processor, memory, a transmitter and a display. (Fig. 1 and 3 Col. 7 lines 41-55) Bork differs from the claimed invention by not mentioning a listing of the identifiers on a display that can be sorted by distance and direction. However, Hendrey teaches a method and system for selectively connecting mobile users for communication based on physical proximity that includes a communication device (Fig. 2 [201]) with a proximity sorting system. (Fig. 2 [222], Col. 1 lines 14-19 and Col. 10 lines 1-21) Hendrey teaches a message with location information and a request for a match making with a closely located user. (Col.

9 lines 54-67) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the proximity sorting communications device of Hendrey into the handheld computer communications system of Bork. One of ordinary skill in the art would have been motivated to do this since sorting the distance to different objects can minimize the traveling distance between multiple objects.

Regarding claim 17, the limitations of the claim are rejected as being the same reason set forth in claim 9.

Regarding claim 18, the limitations of the claim are rejected as being the same reason set forth in claim 2.

Regarding claim 19, the limitations of the claim are rejected as being the same reason set forth in claim 3.

Regarding claim 20, the limitations of the claim are rejected as being the same reason set forth in claim 4.

Regarding claim 21, the limitations of the claim are rejected as being the same reason set forth in claim 5.

Regarding claim 23, the limitations of the claim are rejected as being the same reason set forth in claim 1.

Regarding claim 24, Bork discloses a handheld computer, a list of indicators, a user interface and a display. (Col. 1 lines 31-35, Col. 3 lines 44-47 and Fig. 3) Bork differs from the claimed invention by not mentioning a listing of the identifiers on a display that can be sorted by distance and direction. However, Hendrey teaches a method and system for selectively connecting mobile users for communication based on physical proximity that includes a communication device (Fig. 2 [201]) with a proximity

sorting system. (Fig. 2 [222], Col. 1 lines 14-19 and Col. 10 lines 1-21) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the proximity sorting communications device of Hendrey into the handheld computer communications system of Bork. One of ordinary skill in the art would have been motivated to do this since sorting the distance to different objects can minimize the traveling distance between multiple objects.

Regarding claim 25, the limitations of the claim are rejected as being the same reason set forth in claim 9.

Regarding claim 26, the limitations of the claim are rejected as being the same reason set forth in claim 2.

Regarding claim 27, the limitations of the claim are rejected as being the same reason set forth in claim 3.

Regarding claim 28, the limitations of the claim are rejected as being the same reason set forth in claim 4.

Regarding claim 29, the limitations of the claim are rejected as being the same reason set forth in claim 5.

Claims 6, 14, 22, 30 and 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Bork in view of Hendrey as applied to claim 1 above, and further in view of Kikinis et al (US-6,389,290 hereafter, Kikinis).

Regarding claim 6, Bork in view of Hendrey discloses a method of sorting a list by distance and direction. (Hendrey Fig. 2 [222], Col. 1 lines 14-19 and Col. 10 lines 1-21) Bork in view of Hendrey differs from the claimed invention in that he does not

specifically state that electronic pinging provides the distance and direction. However, Kikinis discloses using pinging to locate a mobile user in a network. (Col. 4 lines 40-47) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to sort the list by distance and direction of Bork in view of Hendrey using pinging like Kikinis. One of ordinary skill in the art would have been motivated to do this since it makes it possible to locate people easily and accurately when GPS services are not available. (Col. 4 lines 40-47)

Regarding claim 14, the limitations of the claim are rejected as being the same reason set forth in claim 6.

Regarding claim 22, the limitations of the claim are rejected as being the same reason set forth in claim 6.

Regarding claim 30, the limitations of the claim are rejected as being the same reason set forth in claim 6.

Regarding claim 31, the limitations of the claim are rejected as being the same reason set forth in claim 6.

(10) Response to Argument

With respect to the Appellant's argument that *the Examiner has failed to establish a prima facie case of obviousness* (Pages 6-7), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of

the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

With respect to the Appellant's argument pertaining to claims 1-5 that *the combination of Bork and Hendrey does not teach or suggest the limitation of "listing each identifier on a display, wherein the list is sorted in order of at least one of distance and direction from the handheld computer"* (Page 7 Para 1), the Examiner disagrees.

Bork is directed to a wireless device that is capable of determining the location of other devices by analyzing location data received through cellular or BLUETOOTH communications and displaying the current direction/distance to the remote device. (Col. 1 lines 31-47 and Fig. 2) Hendrey is directed to a system for selectively connecting mobile telecommunication users based on the users' attributes and physical location. (Col. 2 lines 39-62)

Hendrey teaches "the user of TU **201** selects and activates a group list **220**, when more than one are present in the TU **201**, or the user may only activate a group connection feature if only one group list **220** is available." (Fig. 2 and Col. 6 lines 23-26) Hendrey further teaches, "The user of TU **201** may also optionally select a predetermined maximum connection distance" (Col. 6 lines 26-28), "matchmaker **107** accesses user attribute profile information **131** and creates a list of the best matches between the initiator and other users who have registered with the matchmaker **107**. This list may be sorted in order of best match first for later processing, or may be sorted by proximate distance of possible matches" (Col. 10 lines 1-6) and "matchmaker **107** may be partially or entirely a person using a telecommunication device and having

access to distance information provided by telecommunication infrastructure **120**." (Col. 12 lines 52-56).

The Appellant is arguing that Hendrey, *viewed as a whole, teaches that a separate matchmaker creates a list in response to user initiation, but does not provide it to the user for display.* However, in Col. 12 lines 52-56, Hendrey clearly teaches that the matchmaker could be automated (and separate as Appellant argues) but alternatively also explicitly recites that the matchmaker could "be partially or entirely a person using a telecommunication device and having access to distance information". The Examiner considers that in order for a user to perform the functions of selecting users from a filtered list and calling each user on the list that the list must logically be displayed on a display to the matchmaking user.

The Appellants further argues that, in Hendrey, *group members within a maximum distance are selected (into a list) but the list is not sorted based on distance values.* However, in Col. 10 lines 1-6, Hendrey explicitly recites that the list "may be sorted by proximate distance". Therefore, when viewed as a whole, Hendrey clearly provides the claimed teachings.

Further, the Examiner notes that a step of "sorting" is not claimed, only that the list ~~will~~ be sorted by distance or direction. Clearly, in the case that only 1 or 2 contacts meet the criteria, the lists would inherently be sorted, as broadly claimed. In the example shown in Hendrey's Fig. 2, a list with two entries, the Examiner submits that regardless of the two values of "Dist. #1" and "Dist. #2", with only two entries, the list is either sorted greatest to lowest or lowest to greatest and therefore, clearly meets the broadly claimed "sorted" limitation.

Since Hendrey teaches a person can perform matchmaker functions, the Examiner cannot imagine an efficient method of manipulating lists of user identifiers and relative distances without showing the lists of data on a display. Therefore, when viewed as a whole, Hendrey clearly teaches listing each identifier on a display, sorting the list in order of at least one of distance and direction from the handheld computer.

With respect to the Appellant's argument pertaining to *the user does not select callees from a list, but merely provides the predefined criteria, which is then used to identify callees with whom a connection is then automatically initiated* (Page 7 Para 3), the Examiner disagrees.

The Appellant, on Page 8 full Para 1 states "With regard to Fig. 2 and item 222, Applicant submits that, viewed as a whole, Hendrey teaches that group members within a maximum distance are selected". In the Examiner's opinion, the proceeding two statements contradict each other. Further, Hendrey teaches the telecommunication unit **201** may select users within group list **220** who meet a predetermined distance criterion, or the telecommunications infrastructure **120** may select the users who are within a predefined distance of the TU **201**. (Col. 6 lines 49-53) Hendrey teaches one mode of operation for his invention is an automated triggering system rather than occurring at the specific request of a telecommunications unit user. (Col. 15 lines 16-29) Therefore, when viewed as a whole, Hendrey obviously teaches two modes for selecting callees, an automated connection by the telecommunications infrastructure and a manual connection by the user of the telecommunication unit (which includes cellular telephones and PDAs). (Col. 4 lines 40-53 and Col. 6 line 49 through Col. 7 line 3)

With respect to the Appellant's argument pertaining to *Hendrey does not teach or suggest listing identifiers on a display where the list is sorted in order of distance and/or direction* (Page 8 Para 1), the Examiner disagrees.

Hendrey teaches "the user of TU **201** selects and activates a group list **220**, when more than one are present in the TU **201**, or the user may only activate a group connection feature if only one group list **220** is available." (Fig. 2 and Col. 6 lines 23-26) Hendrey further teaches, "The user of TU **201** may also optionally select a predetermined maximum connection distance" (Col. 6 lines 26-28), "matchmaker **107** accesses user attribute profile information **131** and creates a list of the best matches between the initiator and other users who have registered with the matchmaker **107**. This list may be sorted in order of best match first for later processing, or may be sorted by proximate distance of possible matches" (Col. 10 lines 1-6) and "matchmaker **107** may be partially or entirely a person using a telecommunication device and having access to distance information provided by telecommunication infrastructure **120**." (Col. 12 lines 52-56)

The Appellant is arguing that Hendrey, *viewed as a whole, teaches that a separate matchmaker creates a list in response to user initiation, but does not provide it to the user for display.* However, in Col. 12 lines 52-56, Hendrey clearly teaches that the matchmaker could be automated (and separate as Appellant argues) but alternatively also explicitly recites that the matchmaker could "be partially or entirely a person using a telecommunication device and having access to distance information". The Examiner considers that in order for a user to perform the functions of selecting

users from a filtered list and calling each user on the list that the list must logically be displayed on a display to the matchmaking user.

The Appellants further argues that, in Hendrey, *group members within a maximum distance are selected (into a list) but the list is not sorted based on distance values.* However, in Col. 10 lines 1-6, Hendrey explicitly recites that the list "may be sorted by proximate distance". Therefore, when viewed as a whole, Hendrey clearly provides the claimed teachings.

Further, the Examiner notes that a step of "sorting" is not claimed, only that the list will be sorted by distance or direction. Clearly, in the case that only 1 or 2 contacts meet the criteria, the lists would inherently be sorted, as broadly claimed. In the example shown in Hendrey's Fig. 2, a list with two entries, the Examiner submits that regardless of the two values of "Dist. #1" and "Dist. #2", with only two entries, the list is either sorted greatest to lowest or lowest to greatest and therefore, clearly meets the broadly claimed "sorted" limitation.

Since Hendrey teaches a person can perform matchmaker functions, the Examiner cannot imagine an efficient method of manipulating lists of user identifiers and relative distances without showing the lists of data on a display. Therefore, when viewed as a whole, Hendrey clearly teaches listing each identifier on a display, sorting the list in order of at least one of distance and direction from the handheld computer.

With respect to the Appellant's argument pertaining to Hendrey *does not teach that members of a group list 220 are sorted in group list 220 based on distance values in distance entry 222* (Page 8 Para 1), the Examiner disagrees.

Hendrey teaches the group list 220 is stored in the memory of server 105. (Col. 7 line 61 through Col. 8 line 9) Hendrey teaches filtering group list 220 by distance criterion. As is well known in the art, servers on a network often share and modify files located on adjacent servers. Hendry further teaches the matchmaker service can sort lists in order to determine the best match, the sorting includes by proximate distance. (Col. 10 lines 1-6) Therefore, when viewed as a whole, Hendrey obviously teaches the capability to sort lists stored in memory based on distances.

With respect to the Appellant's argument pertaining to *Hendrey teaches only that a user provides predetermined criteria, with which a separate matchmaker may generate a list that is not displayed to the user, but which is used to simply initiate a wireless connection and fails to teach or suggest "listing each identifier on a display, wherein the list is sorted in order of at least one of distance and direction from the handheld computer* (Pages 8-9), the Examiner disagrees.

Bork is directed to a wireless device that is capable of determining the location of other devices by analyzing location data received through cellular or BLUETOOTH communications and displaying the current direction/distance to the remote device. (Col. 1 lines 31-47 and Fig. 2) Hendrey is directed to a system that includes one embodiment for selectively connecting mobile telecommunication users based on the users' attributes and physical location. (Col. 2 lines 39-62) Hendrey teaches "the user of TU **201** selects and activates a group list **220**, when more than one are present in the TU **201**, or the user may only activate a group connection feature if only one group list **220** is available." (Fig. 2 and Col. 6 lines 23-26) Hendrey further teaches, "The user of

TU **201** may also optionally select a predetermined maximum connection distance" (Col. 6 lines 26-28), "matchmaker **107** accesses user attribute profile information **131** and creates a list of the best matches between the initiator and other users who have registered with the matchmaker **107**. This list may be sorted in order of best match first for later processing, or may be sorted by proximate distance of possible matches" (Col. 10 lines 1-6) and "matchmaker **107** may be partially or entirely a person using a telecommunication device and having access to distance information provided by telecommunication infrastructure **120**." (Col. 12 lines 52-56)

The Appellant is arguing that Hendrey, *viewed as a whole, teaches that a separate matchmaker creates a list in response to user initiation, but does not provide it to the user for display.* However, in Col. 12 lines 52-56, Hendrey clearly teaches that the matchmaker could be automated (and separate as Appellant argues) but alternatively also explicitly recites that the matchmaker could "be partially or entirely a person using a telecommunication device and having access to distance information". The Examiner considers that in order for a user to perform the functions of selecting users from a filtered list and calling each user on the list that the list must logically be displayed on a display to the matchmaking user.

The Appellants further argues that, in Hendrey, *group members within a maximum distance are selected (into a list) but the list is not sorted based on distance values.* However, in Col. 10 lines 1-6, Hendrey explicitly recites that the list "may be sorted by proximate distance". Therefore, when viewed as a whole, Hendrey clearly provides the claimed teachings.

Further, the Examiner notes that a step of "sorting" is not claimed, only that the list will be sorted by distance or direction. Clearly, in the case that only 1 or 2 contacts meet the criteria, the lists would inherently be sorted, as broadly claimed. In the example shown in Hendrey's Fig. 2, a list with two entries, the Examiner submits that regardless of the two values of "Dist. #1" and "Dist. #2", with only two entries, the list is either sorted greatest to lowest or lowest to greatest and therefore, clearly meets the broadly claimed "sorted" limitation.

Since Hendrey teaches a person can perform matchmaker functions, the Examiner cannot imagine an efficient method of manipulating lists of user identifiers and relative distances without showing the lists of data on a display. Therefore, when viewed as a whole, Bork in view of Hendrey clearly teaches listing each identifier on a display, sorting the list in order of at least one of distance and direction from the handheld computer and that the Examiner has established a prima facie case of obviousness for independent claim 1.

With respect to the Appellant's argument pertaining to claims 8-13 and 15, that *the combination of Bork and Hendrey does not teach or suggest listing identifiers on a display where the list is sorted in order of one or both of distance and direction* (Page 10 Para 1), the Examiner disagrees.

Hendrey teaches "the user of TU **201** selects and activates a group list **220**, when more than one are present in the TU **201**, or the user may only activate a group connection feature if only one group list **220** is available." (Fig. 2 and Col. 6 lines 23-26) Hendrey further teaches, "The user of TU **201** may also optionally select a

predetermined maximum connection distance" (Col. 6 lines 26-28), "matchmaker **107** accesses user attribute profile information **131** and creates a list of the best matches between the initiator and other users who have registered with the matchmaker **107**. This list may be sorted in order of best match first for later processing, or may be sorted by proximate distance of possible matches" (Col. 10 lines 1-6) and "matchmaker **107** may be partially or entirely a person using a telecommunication device and having access to distance information provided by telecommunication infrastructure **120**." (Col. 12 lines 52-56)

The Appellant is arguing that Hendrey, *viewed as a whole, teaches that a separate matchmaker creates a list in response to user initiation, but does not provide it to the user for display.* However, in Col. 12 lines 52-56, Hendrey clearly teaches that the matchmaker could be automated (and separate as Appellant argues) but alternatively also explicitly recites that the matchmaker could "be partially or entirely a person using a telecommunication device and having access to distance information". The Examiner considers that in order for a user to perform the functions of selecting users from a filtered list and calling each user on the list that the list must logically be displayed on a display to the matchmaking user.

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Since Hendrey teaches a person can perform matchmaker functions, the Examiner cannot imagine an efficient method of manipulating lists of user identifiers and relative distances without showing the lists of data on a display. Therefore, when viewed as a whole, Hendrey clearly teaches listing each identifier on a display, sorting the list in order of at least one of distance and direction from the handheld computer.

With respect to the Appellant's argument pertaining to claims 16-21 and 23, *Hendrey does not teach or suggest listing identifiers on a display where the list is sorted in order of one or both of distance and direction* (Page 11-12), the Examiner disagrees.

Hendrey teaches "the user of TU **201** selects and activates a group list **220**, when more than one are present in the TU **201**, or the user may only activate a group connection feature if only one group list **220** is available." (Fig. 2 and Col. 6 lines 23-26) Hendrey further teaches, "The user of TU **201** may also optionally select a predetermined maximum connection distance" (Col. 6 lines 26-28), "matchmaker **107** accesses user attribute profile information **131** and creates a list of the best matches between the initiator and other users who have registered with the matchmaker **107**.

This list may be sorted in order of best match first for later processing, or may be sorted by proximate distance of possible matches" (Col. 10 lines 1-6) and "matchmaker **107** may be partially or entirely a person using a telecommunication device and having access to distance information provided by telecommunication infrastructure **120**." (Col. 12 lines 52-56)

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The Appellants further argues that, in Hendrey, *group members within a maximum distance are selected (into a list) but the list is not sorted based on distance values.* However, in Col. 10 lines 1-6, Hendrey explicitly recites that the list "may be sorted by proximate distance". Therefore, when viewed as a whole, Hendrey clearly provides the claimed teachings.

Further, the Examiner notes that a step of "sorting" is not claimed, only that the list will be sorted by distance or direction. Clearly, in the case that only 1 or 2 contacts meet the criteria, the lists would inherently be sorted, as broadly claimed. In the example shown in Hendrey's Fig. 2, a list with two entries, the Examiner submits that

regardless of the two values of "Dist. #1" and "Dist. #2", with only two entries, the list is either sorted greatest to lowest or lowest to greatest and therefore, clearly meets the broadly claimed "sorted" limitation.

Since Hendrey teaches a person can perform matchmaker functions, the Examiner cannot imagine an efficient method of manipulating lists of user identifiers and relative distances without showing the lists of data on a display. Therefore, when viewed as a whole, Hendrey clearly teaches listing each identifier on a display, sorting the list in order of at least one of distance and direction from the handheld computer and that the Examiner has established a prima facie case of obviousness for independent claim 16.

With respect to the Appellant's argument pertaining to claims 24-29, *Hendrey does not teach or suggest listing identifiers on a display where the list is sorted in order of one or both of distance and direction* (Page 12-13), the Examiner disagrees.

Hendrey teaches "the user of TU **201** selects and activates a group list **220**, when more than one are present in the TU **201**, or the user may only activate a group connection feature if only one group list **220** is available." (Fig. 2 and Col. 6 lines 23-26) Hendrey further teaches, "The user of TU **201** may also optionally select a predetermined maximum connection distance" (Col. 6 lines 26-28), "matchmaker **107** accesses user attribute profile information **131** and creates a list of the best matches between the initiator and other users who have registered with the matchmaker **107**. This list may be sorted in order of best match first for later processing, or may be sorted by proximate distance of possible matches" (Col. 10 lines 1-6) and "matchmaker **107**

may be partially or entirely a person using a telecommunication device and having access to distance information provided by telecommunication infrastructure **120**." (Col. 12 lines 52-56)

The Appellant is arguing that Hendrey, *viewed as a whole, teaches that a separate matchmaker creates a list in response to user initiation, but does not provide it to the user for display.* However, in Col. 12 lines 52-56, Hendrey clearly teaches that the matchmaker could be automated (and separate as Appellant argues) but alternatively also explicitly recites that the matchmaker could "be partially or entirely a person using a telecommunication device and having access to distance information". The Examiner considers that in order for a user to perform the functions of selecting users from a filtered list and calling each user on the list that the list must logically be displayed on a display to the matchmaking user.

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Further, the Examiner notes that a step of "sorting" is not claimed, only that the list will be sorted by distance or direction. Clearly, in the case that only 1 or 2 contacts meet the criteria, the lists would inherently be sorted, as broadly claimed. In the example shown in Hendrey's Fig. 2, a list with two entries, the Examiner submits that regardless of the two values of "Dist. #1" and "Dist. #2", with only two entries, the list is

either sorted greatest to lowest or lowest to greatest and therefore, clearly meets the broadly claimed "sorted" limitation.

Since Hendrey teaches a person can perform matchmaker functions, the Examiner cannot imagine an efficient method of manipulating lists of user identifiers and relative distances without showing the lists of data on a display. Therefore, when viewed as a whole, Hendrey clearly teaches listing each identifier on a display, sorting the list in order of at least one of distance and direction from the handheld computer and that the Examiner has established a prima facie case of obviousness for independent claim 24.

With respect to the Appellant's argument that there is no suggestion to combine the references (Pages 13-14), the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, it is the Examiner's opinion that the Appellant is not viewing Hendrey as a whole. For instance, Hendrey specifically teaches the use of global positioning systems, time difference of arrival and angle of arrival for determining the location of telecommunication users. (Col. 5 lines 26-41) Hendrey teaches, "notions of distance are in particular intended to encompass not only literal distance measure, but additionally any and all measures conducive to identifying a set of users who would

have the least difficult separation to overcome in order to attend a physical group meeting". (Col. 8 lines 56-67) The teachings of Hendrey coincide with the teachings of Bork in that not only the physical distance between mobile devices is taken into account but also the path of least resistance when determining a place for a physical group meeting between the mobile users. (Bork Fig. 2, Col. 4 line 54 through Col. 5 line 67, and Hendrey Col. 8 lines 56-67)

Therefore, when viewing the combination of Bork in view of Hendrey as a whole, the teachings lead the Examiner to a mobile device that allows for the searching, sorting and connecting of users located proximately to each other, taking into account the distance, direction and path of least resistance between the mobile devices. (Bork Fig. 2, Col. 4 line 54 through Col. 5 line 67, Hendrey Col. 6 line 1 through Col. 7 line 3, Col. 8 lines 56-67, Col. 9 lines 45-53 Col. 10 lines 1-39 and Col. 12 lines 38-56)

With respect to the Appellant's argument pertaining to claims 6, 14, 22, 30 and 31 (Page 15), the Appellant is relying upon the dependence of claims 1, 8, 16 and 24 and presumed deficiencies of the Examiner's rejections. Since the Examiner has established a prima facie case of obviousness for independent claims 1, 8, 16 and 24, and no new issues are raised for dependent claims 6, 14, 22 30 and 31, the Examiner's original rejection stands in view of further defined reasoning stated above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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July 7, 2006

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